

## **REMARKS/ARGUMENTS**

### **Status of Claims**

Claims 1-20 are pending in the present application. In the Office Action, claims 1-3, 5-13 and 15-20 were rejected and claims 4 and 14 were previously withdrawn. In response to the Office Action and concurrent with a Request for Continued Examination, Applicants have amended claims 1 and 11. No new matter has been added. Applicants respectfully request reexamination and reconsideration of the pending claims.

### **Information Disclosure Statement**

In the Office Action, the Examiner reported that information included in an Information Disclosure Statement filed on March 12, 2008 failed to comply with 37 CFR 1.98(a)(2). Applicants will file a Supplemental IDS to address these issues and respectfully request that these references be considered during prosecution.

### **Claim Rejections - 35 U.S.C. § 103**

Chermoni in view of Keith - Office Action Paragraph 5. Claims 1-2, 5-12, 15-18 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Chermoni* (U.S. Pub. No. 2002/0156496 A1) in view of *Keith* (U.S. Pat. No. 6,070,589). Applicants respectfully submit that the amendments to the claims overcome this rejection for at least the following reasons.

Claims 1 and 11 of the instant application have been amended to recite, in part, a shuttle "wherein the outer surface of the shuttle is free of surface features that prohibit positioning of a stent segment along the outer surface, and wherein the outer surface of the shuttle is adapted to allow a pair of adjacent stents to be positioned into direct engagement with one another." Support for these amendments may be found, for example, in the published application at paragraph 43 of the specification and in Fig. 4. The cited references fail to teach each and every element of these claims as amended.

*Chermoni* fails to teach or suggest a shuttle "wherein the outer surface of the shuttle is free of surface features that prohibit positioning of a stent segment along the outer surface, and wherein the outer surface of the shuttle is adapted to allow a pair of adjacent stents to be positioned into direct engagement with one another." *Chermoni* discloses a cylindrical carriage bearing "a plurality of annular depressions ... configured to receive a stent" (Par. 39 and Figs. 6 - 10). This feature is inconsistent with the elements of claims 1 and 11 of the instant application reciting an "outer surface of the shuttle ... free of surface features that prohibit positioning of a stent segment along the shuttle" and an "outer surface of the shuttle ... adapted to allow a pair of adjacent stents to be positioned into direct engagement with one another." The annular depressions of *Chermoni* prevent both advancement of stents along the cylindrical carriage and direct engagement between adjacent stents. Further, by seeking to prevent direct engagement between adjacent stent segments and positioning of stent segments as recited, the use of the annular depressions in *Chermoni* teaches away from the device as claimed in the instant application.

The missing features of *Chermoni* are not provided by *Keith*. *Keith* discloses a graftstent that is carried in the sheath to which it is affixed by use of anchor lines (Col. 9, lines 45-67); *Keith* does not disclose, teach or suggest a shuttle of any kind. Further, by affixing the graftstent to the sheath with anchor lines, the graftstent is prohibited from being positioned relative to the sheath. By seeking to prevent positioning of the graftstent, *Keith* teaches away from the device as claimed in the instant application.

For at least these reasons, Applicants submit that the cited references do not teach or suggest all of the elements of claims 1 or 11 of the instant application. Claims 2, 5-10, 12, 15-18 and 20 depend from independent claims 1 and 11. Accordingly, the cited references also fail to support the rejection of the dependent claims for at least the same reasons set forth above.

Because the cited references, alone or in combination, fail to teach or suggest each and every element of the claimed invention, *prima facie* obviousness cannot be established under 35 U.S.C. § 103(a). Therefore, Applicants respectfully request that the rejection of these claims be withdrawn and the claims allowed.

Chermoni in view of Keith and Shaknovich - Office Action Paragraph 6. Claims 3 and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Chermoni* in view of *Keith* and further in view of *Shaknovich* (U.S. Pat. No. 5,807,398). Applicants respectfully traverse this rejection in part and overcome this rejection in part for at least the following reasons.

The Office Action suggests that the shuttle of *Shaknovich* "is fixedly disposed over at least part of the catheter shaft and the expandable member" as required in claims 3 and 13 of the instant application (Office Action par. 6, page 6). However, the *Shaknovich* apparatus operates by the advancement of the shuttle over the shaft of the balloon catheter (Col. 5, lines 54-55 and Fig. 3.). One element moves over the other. They cannot be fixed relative to one another or this movement would be prevented. The *Shaknovich* device would be inoperative if the shuttle were "fixedly disposed over at least part of the catheter shaft and the expandable member." Therefore, *Shaknovich* does not teach or suggest a fixed disposition of the shuttle "over at least part of the catheter shaft and the expandable member," as recited in claims 3 and 13 of the instant application, and, in fact, teaches away from this construction.

In addition, as previously discussed, the cited references, *Chermoni* and *Keith*, do not support the rejection of independent claims 1 and 11, as amended, because they do not teach or suggest each and every element of the claims. Specifically, *Chermoni* and *Keith* do not teach or suggest a shuttle "wherein the outer surface of the shuttle is free of surface features that prohibit positioning of a stent segment along the outer surface, and wherein the outer surface of the shuttle is adapted to allow a pair of adjacent stents to be positioned into direct engagement with one another."

The missing features of *Chermoni* and *Keith* are not provided by *Shaknovich*. *Shaknovich* discloses a shuttle carrying stent segments (Fig. 1), where the stent segments are "compacted over an expandable portion" of the shuttle and "flanked by non-expandable segments" and thus in a fixed position relative to the shuttle (Col. 5, lines 31-36). These features prohibit "positioning of a stent segment along the outer surface." Further, *Shaknovich* discloses that the stent segments are positioned for deployment by moving the shuttle, bearing stent segments, to the proper location within the vessel (Col. 5, lines 49-56 and Fig. 3). This is

inconsistent with "positioning of a stent segment along the outer surface" as recited in claims 1 and 11 of the instant application. Indeed, *Shaknovich* teaches away from "positioning of a stent segment along the outer surface" of the shuttle because doing so, on the *Shaknovich* shuttle, would dispose a stent segment over a "non-expandable segment" of the shuttle and render it inoperative for its intended purpose.

For at least these reasons, Applicants submit that the cited references do not teach or suggest all of the elements of claims 1 or 11 of the instant application. Claims 3 and 10 depend from independent claims 1 and 11, respectively. Accordingly, the cited references also fail to support the rejection of the dependent claims for at least the same reasons set forth above.

Because the cited references, alone or in combination, fail to teach or suggest each and every element of the claimed invention, *prima facie* obviousness cannot be established under 35 U.S.C. § 103(a). Therefore, Applicants respectfully request that the rejection of these claims be withdrawn and the claims allowed.

*Chermoni* in view of *Keith* and *Martinez* - Office Action Paragraph 7. Claim 19 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Chermoni* in view of *Keith* and further in view of *Martinez* (U.S. Pat. No. 5,593,412). Applicants respectfully submit that the amendments to the claims overcome this rejection for at least the following reasons.

As previously discussed, the cited references, *Chermoni* and *Keith*, do not support the rejection of independent claim 11, as amended, because they do not teach or suggest each and every element of the claim. Specifically, the cited references do not teach or suggest a shuttle "wherein the outer surface of the shuttle is free of surface features that prohibit positioning of a stent segment along the outer surface, and wherein the outer surface of the shuttle is adapted to allow a pair of adjacent stents to be positioned into direct engagement with one another."

The missing features of *Chermoni* and *Keith* are not provided by *Martinez*. *Martinez* discloses the deployment of stent segments by placement directly on a balloon catheter or on a balloon guidewire (Col. 4, lines 15-17). It does not disclose, teach or suggest a shuttle of any kind.

For at least these reasons, Applicants submit that the cited references do not teach or suggest all of the elements of claim 11 of the instant application. Claim 19 depends from

independent claim 11. Accordingly, the cited references also fail to support the rejection of the dependent claims for at least the same reasons set forth above.

Because the cited references, alone or in combination, fail to teach or suggest each and every element of the claimed invention, *prima facie* obviousness cannot be established under 35 U.S.C. § 103(a). Therefore, Applicants respectfully request that the rejection of these claims be withdrawn and the claims allowed.

*Chermoni* in view of *Keith* and *Palermo* - Office Action Paragraph 8. Claim 19 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Chermoni* in view of *Keith* and further in view of *Palermo* (U.S. Pat. No. 5,312,415). Applicants respectfully submit that the amendments to the claims overcome this rejection for at least the following reasons.

As discussed above, the cited references, *Chermoni* and *Keith*, do not support the rejection of independent claim 11, as amended, because they do not teach or suggest each and every element of the claims. Specifically, the cited references do not teach or suggest a shuttle "wherein the outer surface of the shuttle is free of surface features that prohibit positioning of a stent segment along the outer surface, and wherein the outer surface of the shuttle is adapted to allow a pair of adjacent stents to be positioned into direct engagement with one another."

The missing features of *Chermoni* and *Keith* are not provided by *Palermo*. *Palermo* discloses the deployment of embolic coils mounted on a guidewire (Col. 4). It does not disclose, teach or suggest a shuttle of any kind.

For at least these reasons, Applicants submit that the cited references do not teach or suggest all of the elements of claim 11 of the instant application. Claim 19 depends from independent claim 11. Accordingly, the cited references also fail to support the rejection of the dependent claims for at least the same reasons set forth above.

Because the cited references, alone or in combination, fail to teach or suggest each and every element of the claimed invention, *prima facie* obviousness cannot be established under 35 U.S.C. § 103(a). Therefore, Applicants respectfully request that the rejection of these claims be withdrawn and the claims allowed.

*Shaknovich* in view of *Keith* - Office Action Paragraph 9. Claims 1-3, 5-9, 11-13, 15-17, and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Shaknovich* in

view of *Keith*. Applicants respectfully submit that the amendments to the claims overcome this rejection for at least the following reasons.

As explained above, the cited references, *Shaknovich* and *Keith*, do not support the rejection of independent claims 1 and 11, as amended, because they do not teach or suggest each and every element of the claims. Specifically, the cited references do not teach or suggest a shuttle "wherein the outer surface of the shuttle is free of surface features that prohibit positioning of a stent segment along the outer surface, and wherein the outer surface of the shuttle is adapted to allow a pair of adjacent stents to be positioned into direct engagement with one another."

*Shaknovich* discloses a shuttle carrying stent segments (Fig. 1), where the stent segments are "compacted over an expandable portion" of the shuttle and "flanked by non-expandable segments" and thus in a fixed position relative to the shuttle (Col. 5, lines 31-36). These features prohibit "positioning of a stent segment along the outer surface." Further, *Shaknovich* discloses that the stent segments are positioned for deployment by moving the shuttle to the proper location within the vessel (Col. 5, lines 49-56 and Fig. 3). This is inconsistent with "positioning of a stent segment along the outer surface" as taught in claims 1 and 11 of the instant application. Indeed, *Shaknovich* teaches away from "positioning of a stent segment along the outer surface" of the shuttle because doing so, on the *Shaknovich* shuttle, would dispose a stent segment over a "non-expandable segment" of the shuttle and render it inoperative for its intended purpose.

The missing features of *Shaknovich* are not provided by *Keith*. *Keith* discloses a graftstent that is carried in the sheath to which it is affixed by use of anchor lines (Col. 9, lines 45-67); *Keith* does not disclose, teach or suggest a shuttle of any kind.

For at least these reasons, Applicants submit that the cited references do not teach or suggest all of the elements of claims 1 or 11 of the instant application. Claims 2-3, 5-9, 12-13, 15-17 and 20 depend from independent claims 1 and 11. Accordingly, the cited references also fail to support the rejection of the dependent claims for at least the same reasons set forth above.

Because the cited references, alone or in combination, fail to teach or suggest each and every element of the claimed invention, *prima facie* obviousness cannot be established

under 35 U.S.C. § 103(a). Therefore, Applicants respectfully request that the rejection of these claims be withdrawn and the claims allowed.

Shaknovich in view of Keith and Chermoni - Office Action Paragraph 10. Claims 10 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Shaknovich* in view of *Keith* and further in view of *Chermoni*. Applicants respectfully submit that the amendments to the claims overcome this rejection for at least the following reasons.

As explained above, the cited references, *Shaknovich*, *Keith* and *Chermoni*, do not support the rejection of independent claims 1 and 11, as amended, because they do not teach or suggest each and every element of the claims. Specifically, the cited references do not teach or suggest a shuttle "wherein the outer surface of the shuttle is free of surface features that prohibit positioning of a stent segment along the outer surface, and wherein the outer surface of the shuttle is adapted to allow a pair of adjacent stents to be positioned into direct engagement with one another."

For at least these reasons, Applicants submit that the cited references do not teach or suggest all of the elements of claims 1 or 11 of the instant application. Claims 10 and 18 depend from independent claims 1 and 11, respectively. Accordingly, the cited references also fail to support the rejection of the dependent claims for at least the same reasons set forth above.

Because the cited references, alone or in combination, fail to teach or suggest each and every element of the claimed invention, *prima facie* obviousness cannot be established under 35 U.S.C. § 103(a). Therefore, Applicants respectfully request that the rejection of these claims be withdrawn and the claims allowed.

Shaknovich in view of Keith and Palermo - Office Action Paragraph 11. Claim 19 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Shaknovich* in view of *Keith* and further in view of *Palermo*. Applicants respectfully submit that the amendments to the claims overcome this rejection for at least the following reasons.

As explained above, the cited references, *Shaknovich*, *Keith* and *Palermo*, do not support the rejection of independent claim 11, as amended, because they do not teach or suggest each and every element of the claim. Specifically, the cited references do not teach or suggest a

shuttle "wherein the outer surface of the shuttle is free of surface features that prohibit positioning of a stent segment along the outer surface, and wherein the outer surface of the shuttle is adapted to allow a pair of adjacent stents to be positioned into direct engagement with one another."

For at least these reasons, Applicants submit that the cited references do not teach or suggest all of the elements of claim 11 of the instant application. Claim 19 depends from independent claim 11. Accordingly, the cited references also fail to support the rejection of the dependent claims for at least the same reasons set forth above.

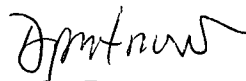
Because the cited references, alone or in combination, fail to teach or suggest each and every element of the claimed invention, *prima facie* obviousness cannot be established under 35 U.S.C. § 103(a). Therefore, Applicants respectfully request that the rejection of these claims be withdrawn and the claims allowed.

### CONCLUSION

In view of the foregoing remarks, Applicants submit that all claims now pending in this Application are in condition for allowance. Applicants, therefore, respectfully request reconsideration of this Application and the timely allowance of the pending claims.

If the Examiner believes a telephone conference would advance prosecution of this application, please contact the undersigned at 650-326-2400.

Respectfully submitted,

  
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